

The opinion in support of the decision being entered today is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC LAMBERTON, JEAN-JACQUES LEGOLL,
PASCAL THUBERT, ERIC LEVY-ABEGNOLI,
and PIERRE SECONDO

Appeal 2007-1356
Application 09/654,857
Technology Center 2100

Decided: July 24, 2007

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand this application to the Examiner to resolve the following
issues:

- (1) Clarify the record as to whether Appellants' evidence establishing
common assignment to disqualify the cited Banavar reference (US

6,662,206 B1) in connection with the rejection of claims 5, 10, and 15
will or will not be entered;

(2) If the evidence is entered, clarify the record as to whether the Banavar reference also qualifies as prior art under § 102(a) in view of potential admissions made by the assignee in the patent irregardless of its date or its disqualification under § 102(e); and

(3) Clarify the status of all claims on appeal in light of the Examiner's decision.

Detailed Discussion

The present application is remanded to the Examiner under 37 C.F.R. § 41.50 for consideration of evidence submitted after filing the notice of appeal pursuant to 37 C.F.R. § 41.33(d). The record before us does not clearly indicate whether such evidence was entered. This deficiency in the record must be resolved by the Examiner before we will evaluate the propriety of the Examiner's rejections involved in the present appeal.

Specifically, in connection with the Examiner's rejection of claims 5, 10, and 15, Appellants contend that the Banavar reference (US 6,662,206 B1) does not qualify as prior art under 35 U.S.C. § 103(c). To support this contention, Appellants submit evidence to establish that Banavar and the claimed invention were commonly assigned at the time the invention was made (Br. 19).

This evidence, however, was presented on this record for the first time in the Appeal Brief filed June 29, 2006.¹ Throughout prosecution, all previous arguments pertaining to the Banavar reference were based on its scope and content and whether the Examiner established a prima facie case of obviousness in combining Banavar with various references.² At no point throughout prosecution prior to the June 2006 Brief, however, did Appellants contend that Banavar did not qualify as prior art. In fact, Appellants' detailed arguments based on Banavar's scope and content suggest that Appellants considered the reference as qualified prior art.

In any event, we recognize that references that qualify as prior art under § 102(e) may be disqualified under § 103(c) upon submitting evidence establishing common ownership or assignment at the time the invention was made. *See* MPEP § 706.02(1)(1) (Rev. 3, Aug. 2005) (hereafter "MPEP"). Although only a clear and conspicuous statement is required to satisfy Appellants' evidentiary burden,³ such a statement nonetheless constitutes *evidence*: evidence that in this case was submitted for the first time in the

¹ This Brief was amended on Sept. 13, 2006 in response to a notice indicating various informalities. Three Appeal Briefs have been filed throughout prosecution in the present application. A first Appeal Brief was filed on Aug. 31, 2005, but prosecution was later reopened. A second Appeal Brief was filed on June 29, 2006. In response to a notice indicating various informalities, Appellants filed a third Appeal Brief on Sept. 13, 2006. Unless otherwise indicated, we refer to the Sept. 2006 Brief throughout this opinion.

² *See* Response filed Jan. 5, 2006, at 15-21; *see also* Appeal Brief filed Aug. 31, 2005, at 15; Response filed Dec. 13, 2004, at 14-17.

³ *See* MPEP § 706.02(1)(2)(II).

June 2006 Appeal Brief.⁴ Such newly-submitted evidence -- like all other evidence submitted for the first time after filing the appeal -- is not entered as a matter of right. *See* 37 C.F.R. § 41.33(d);⁵ *see also* MPEP § 1206(II).

On this record, it is unclear why Appellants did not seasonably present the evidence establishing common assignment. Nevertheless, the record before us is, at best, unclear whether the Examiner *entered* this new evidence – evidence that is potentially dispositive of the rejections of claims 5, 10, and 15. The Examiner merely indicates that Appellants’ common assignment statement “is presented in an untimely manner” and “did not come up during previous prosecution” (Answer 13-14).

Therefore, we remand the case to the Examiner to clarify the record as to whether the Appellants’ evidence establishing common assignment *will or will not be entered*. *See* MPEP § 1206(II); *see also* MPEP § 1211.03.

After deciding whether or not to enter the new evidence, the Examiner must then reevaluate patentability of the claims in light of this decision. If the Examiner decides to maintain some or all of the grounds of rejection previously presented in the Answer, then the Examiner must issue a

⁴ Merely because the common assignment statement is styled as an argument in the Appeal Brief and not presented as a separate paper does not affect the statement’s status as an evidence submission.

⁵ 37 C.F.R. 41.33(d) provides with emphasis added:

(d) (1) An affidavit *or other evidence* filed *after the date of filing an appeal* pursuant to § 41.31(a)(1) through (a)(3) and *prior to the date of filing a brief* pursuant to § 41.37 *may* be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits *or other evidence* filed *after the date of filing an appeal* pursuant to § 41.31(a)(1) through (a)(3) will *not* be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

Supplemental Examiner's Answer setting forth such grounds. The Examiner is reminded that *no new grounds of rejection are permitted* in a Supplemental Answer that is responsive to this type of remand. *See* MPEP § 1207.05(C); *see also* MPEP § 1207.05(III).

In reevaluating patentability, we remind the Examiner that disqualifying a prior art reference under § 103(c) by evidencing common assignment does not apply for prior art that qualifies under § 102(a) (i.e., subject matter that was known or used by others before the present invention). *See* MPEP § 706.02(l)(3).

This may be the case here. Specifically, Banavar discusses several known techniques that appear relevant to the subject matter of claims 5, 10, and 15.⁶ Although the reference does not provide further details regarding these known techniques, the assignee of the present application -- which is the same assignee of the cited patent -- is perhaps in the best position to explain these techniques further given the potential applicability of these techniques to at least claims 5, 10, and 15.

To this end, the Examiner may wish to inquire about these techniques via a Requirement for Information under 37 C.F.R. § 1.105 should further

⁶ For example, Banavar states that “[a]ny *known* ‘session outage notification’ technique...allows the sequencer(s) to detect when the connection has been broken, and similarly, any *known* technique for later re-establishing the connection allows the sequencer to detect when the connection has been re-established (Banavar, col. 8, ll. 4-8) (emphasis added). *See also id.*, at column 1, lines 61-67 (background discussion describing various reasons why subscriber’s access to event message stream cause interruptions).

prosecution follow this remand. *See* MPEP §§ 704.10-14.⁷ Further explanation of these techniques and their applicability to at least claims 5, 10, and 15 may be reasonably necessary to determine the scope and content of the subject matter that qualifies as prior art under § 102(a).

Lastly, we note that Appellants presented an alternative argument to the § 103(c) argument for the first time in the Reply Brief. *See* Reply Br., at 12.⁸ No such argument, however, was presented in the Appeal Brief. *Compare* Reply Br. 12 *with* Br. 19. We consider Appellants' alternative argument waived because it was not raised in Appellants' opening brief. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989, 80 USPQ2d 1839, 1847-48 (Fed. Cir. 2006).

DECISION

The present application on appeal is remanded to the Examiner for appropriate action in accordance with the foregoing instructions.

⁷ *See also Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1283, 73 USPQ2d 1409, 1414 (Fed. Cir. 2005) ("The [USPTO] is clearly entitled to use section 1.105 to seek information that may support a rejection. Just as the applicant produces information it deems pertinent to patentability under section 1.56, the examiner is free to request information under section 1.105 that the examiner deems pertinent to the issue of patentability.").

⁸ Specifically, Appellants argue that "[a]lternatively, if the Board finds that Ganguly-Banavar is a proper combination, then Appellant [sic] kindly directs the Board's attention to pages 15-21 of Appellant's response with a mailing date of January 3, 2006 as arguments to be incorporated herein" (Reply Br. 12).

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Because this application has a “special” status, it requires immediate action. *See* MPEP § 708.01(D). The Board must be informed promptly of any action affecting the appeal in this case.

REMANDED

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